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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,335	11/10/2003	Ivano Vagnoli	141483.00003-P1243US00	5137
25207	7590	04/05/2005	EXAMINER	
POWELL GOLDSTEIN LLP ONE ATLANTIC CENTER FOURTEENTH FLOOR 1201 WEST PEACHTREE STREET NW ATLANTA, GA 30309-3488			WATKINS III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 04/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,335

Applicant(s)

VAGNOLI, IVANO

Examiner

William P. Watkins III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 9-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11-10-2003.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method of making a tile, classified in class 264, subclass 273.
- II. Claims 9-13, drawn to a leather tile with holes, classified in class 428, subclass 131.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I, claims 1-8 and Group II, claims 9-13 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed is not limited to leather tiles and could be used to make wooden or ceramic tiles.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and since the fields of search are not co-extensive, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ms. Cathy Bell for Mr. Jason Bernstein on 2 February 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 9-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claim 11 is objected to because of the following informalities: there is no antecedent basis for the resin layer. Appropriate correction is required.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

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differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liardet (U.S. 4,864,790) in view of Hirsch (U.S. 4,849,145) and Zegler et al. (U.S. 5,567,497) further in view of Yoshimi et al. (U.S. 4,860,506).

Liardet teaches a floor tile or roll with a leather surface and a backing layer joined by adhesive (abstract, col. 9, lines 30-20). Zegler et al. teaches joining a top surface covering that has a layer which will fuse with thermoplastic to a thermoplastic base which has channels (abstract). Hirsch teaches joining thermoplastic to a leather layer by injection of the thermoplastic into holes in the leather layer and around edges of the leather layer (abstract, Figure 5). The instant invention claims a leather floor tile with a thermoplastic backing that has resin which extends through holes in the leather layer and other perforations that are not filled. It would have been obvious to join a thermoplastic as the base layer of Liardet to prevent slipping because of the teachings of Zegler et al. (U.S. 5,567,497). It further would have been obvious to have joined the leather layer and bottom resin layer

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by injecting resin into holes of the leather layer instead of using adhesive because of the teachings of Hirsch. It further would have been obvious to perforate the assembly of Liardet as modified above in order to provide sound reduction because of the teachings of Yoshimi et al.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 9-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-10 of copending Application No. 10/705,256 in view of Yoshimi et al. (U.S. 4,860,506). Although the conflicting claims are not identical, they are not patentably distinct from each other because the sister claims

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teach a leather floor tile with a resin layer. Yoshimi et al. teaches perforations of a floor. The instant invention claims a leather tile with a resin layer and perforations. It would have been obvious to perforate the tile of the sister application in order to provide noise reduction because of the teachings of Yoshimi et al. Only a one way showing is needed as the applications have the same filing date.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WW/ww

April 4, 2005

A handwritten signature in black ink, appearing to read "William P. Watkins III".

**WILLIAM P. WATKINS III
PRIMARY EXAMINER**